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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,095	07/26/2001	Shunpei Yamazaki	07977-082003	2034

7590

06/03/2003

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EXAMINER

PERT, EVAN T

ART UNIT

PAPER NUMBER

2829

DATE MAILED: 06/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/917,095

Applicant(s)

YAMAZAKI ET AL.

Examiner

Evan T. Pert

Art Unit

2829

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/748,233.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The disclosure is objected to because it contains a minor grammatical informality ("excessively value") at p. 3, line 4.

Appropriate correction is required.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 2-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-63 of U.S. Patent No. 6,281,147. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application as amended are merely obvious variants of the claims of U.S. 6,281,147. While a restriction was required in the parent issuing as '147, the amended claims under consideration are drawn to obvious variants of patented claims.

As an example for analysis, pending claim 2 is an obvious variant of patented claim 8:

Patented claim 8 has a longer preamble than pending claim 2, additionally including "in which a step of forming an insulating film by plasma CVD method", but the extra recitation in claim 8 is inherent to both claims since acts of forming an insulating film by CVD are recited in the body of both claims, by the art accepted definition of CVD.

Claim 2 does not recite "preparing a substrate in a reaction chamber", but a substrate is necessarily "prepared in a reaction chamber" in practicing the method recited by claim 2 because an insulating film is formed over "a substrate in the reaction chamber."

Claim 2 describes applying an RF power "between electrodes" while claim 8 does not clarify the art accepted definition of "forming" (i.e. "generating") a plasma necessarily "between electrodes."

Both claim 2 and claim 8 recite first and second voltages wherein the second voltage results from an increase from the first voltage. Claim 8 clarifies the function of the first and second voltages as claim limitations wherein pending claim 2 is broader by not being so limited.

Claim 8 does not recite "forming an insulating film from the first and second gases". However, in view of patented claims 13-15, it would have been obvious to form an insulating film of first and second gas when practicing the method of patented claim 8, motivated to form silicon dioxide.

Claims 3-28 are also obvious variants of the patented claims (analogous with the rejection of claim 2). Claims 3-28, like claim 2, are obvious in view of the patented claims by the meaning of art accepted terminology taken with well-known benefits in the art such as using PECVD for forming silicon dioxide layers as part of active matrix LCD panels.

If applicant disagrees that the pending claims are obvious variants of the identified patented claims, applicant is encouraged to identify patentably distinguishable *concepts* by explaining claim language *conceptually*. This may assist the examiner to identify patentable subject matter.

Response to Amendment

4. Applicant's amendment has overcome rejections under 35 USC 112 and 35 USC 102, but the amended claims fail to define an invention that is patentably distinguishable from the claims of grand-parent application 08/748,233, now U.S. Patent 6,281,147.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evan T. Pert whose telephone number is 703-306-5689. The examiner can normally be reached on M-F (7:00-3:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamand Cuneo can be reached on 703-308-1233. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

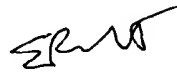
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

ETP
May 27, 2003



EVAN PERJ